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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,674	11/28/2000	Preeti Lal	PF-0539 USN	8930
22428	7590	09/13/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			CANELLA, KAREN A	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/701,674

Applicant(s)

LAL ET AL.

Examiner

Karen A Canella

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1. Claims 1-20 are pending.

#### *Election/Restrictions*

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1, 2 and 15, drawn to drawn to polypeptides of SEQ ID NO:1-31, fragments thereof and pharmaceutical compositions thereof..

Group 2, claim(s) 3-6, 9-14 and 21, drawn to drawn to polynucleotides encoding the polypeptides of Group 1; polynucleotides having at least 90% sequence identity to the polynucleotides encoding the polypeptides of Group 1; polynucleotides which hybridize to the polynucleotides encoding the polypeptides of Group 1; complementary sequence of the polynucleotides encoding the polypeptides of Group 1; polynucleotides comprising SEQ ID NO:32-62 and fragments thereof; polynucleotides having at least 90% identity to polynucleotides comprising SEQ ID NO:32-62, fragments, complementary sequences, expression vectors and host cells thereof; and methods of recombinant expression of a host cell.

Group 3, claim(s) 7 and 8, drawn to methods of detecting the polynucleotides encoding the polypeptide of Group 1.

Group 4, claim(s) 16-18, drawn to antibodies, agonists and antagonists of the polypeptides of Group 1.

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Group 5, claim(s) 19, drawn to a method for treating a disorder associated with decreased expression or activity of PRGE comprising the administration of the pharmaceutical composition of Group 1.

Group 6, claim(s) 20, drawn to a method for treating a disorder associated with increased expression or activity of PRGE comprising the administration of the antagonist of Group 4.

3. The restriction is further subject to an additional restriction based on sequence. With the election of any Group, an additional restriction to one polypeptide sequence is required. Applicant is required to elect one of SEQ ID NO:1-31. In the event that applicant elects a group drawn to polynucleotides or the detection of polynucleotides, the election will be applied to the polynucleotide encoding the elected polypeptide. Please note that this is not an election of species.

4. The inventions listed as Groups 1-6, do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the claims lack unity of invention, because the claims have not been found to provide a contribution over the prior art as evidenced by the International Search Report which cites HILLIER et al as disclosing the subject matter of claims 5, 9 and 11 in AC 634416 and AA063624; Kenichi et al (EP 679,716) as disclosing the subject matter of claims 5 and 9; and Su et al (Genes and Development, 1993, Vol. 7, pp. 735-738) as disclosing the subject matter of claims 1, 3, 5 and 9. Thus, the claims lack unity of invention because they lack an essential feature which distinguishes the instant claims over the prior art.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10 a.m. to 9 p.m. M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571)272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen A. Canella, Ph.D.

9/7/2004

  
**KAREN A. CANELLA PH.D**  
**PRIMARY EXAMINER**